

Remarks

At the time of the Office Action, which was made Final, claims 7-24 were pending. Claims 7-24 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,167,469 to Safai et al. (hereinafter Safai) in view of U.S. Patent No. 5,555,194 to Cok (hereinafter Cok). Furthermore, claims 7, 19 and 22 stand rejected under 35 U.S.C. § 112 second paragraph as being indefinite.

The present response is submitted with a request for continued examination (RCE) to reopen prosecution. In the present response claims 7, 8 and 19-24 are canceled. Accordingly, withdrawal is respectfully requested of the rejections under 35 U.S.C. § 112. Furthermore, claims 9-11 are amended and new claims 25 and 26 are submitted. In view of the claim amendments and newly-submitted claims, the Applicant respectfully requests reconsideration.

As an initial matter, the Applicant takes issue with the combination of Safai and Cok. In particular, the Applicant disagrees with the Examiner's statement on page 5 of the Final Office Action which attempts to justify the combination of these references. The Examiner stated, "...as Safai clearly is running on the Windows CE operating system (see figure 3) any program that could be made for a Windows computer would work on Safai." The Applicant submits that the foregoing statement is false and, moreover, that Cok is not combinable with Safai in view of the following:

As known in the art, software applications (e.g., the cloning function of Cok) are subject to various requirements to be properly installed and executed, the most common requirement being physical computing resources, also known as hardware. Minimum hardware requirements must be satisfied in order for the software to execute/run properly or at all. That is, the physical device on which the software is installed must have the proper processor (or processing speed), memory and the like. Although Safai may run Windows CE, to assume that Safai's camera could run any Windows-compatible program is specious because the Examiner has disregarded the hardware requirement of such a program that implements Cok's method and the computing resources of Safai specifically.

As an example, it is known in the art that the Photoshop Elements (version 2.0) application is subject to system requirements of: a Pentium processor running Windows 98SE/ME/2000/XP; 150 MB hard disk space; and 128 MB of RAM. One can appreciate that the Photoshop Elements (version 2.0) application is installed and run on a personal computer such as a desktop or laptop, not a digital camera such as Safai's which runs Windows CE. If, for argument's sake, the Photoshop Elements (version 2.0) application could be installed on a camera such as is disclosed by Safai, the application could not operate properly or at all. To this end, the Applicant submits that a *prima facie* case of obviousness has not been established because the proposed combination of Safai and Cok would render Cok's cloning method inoperative or at least unsatisfactory for its intended purpose (MPEP 2143.01). Accordingly, the Applicant challenges the Examiner to demonstrate a retouching software application that can suitably execute on a device with Windows CE operating system and a CPU with a 100 MHz clock cycle (col. 5, line 65).

Even if, for argument's sake, Safai and Cok could be properly combined, the Applicant submits that the combination of Safai and Cok fails to anticipate or render obvious the pending claims. Claim 9 as amended and new claim 25 are submitted to more particularly and distinctly recite the Applicant's apparatus and digital camera that performs retouching. In particular, claims 9 and 25 recite structural features such as the buttons (see, for example FIG. 11 of the present application) on the digital camera which facilitate the retouching operation. Although Safai discloses and shows various buttons (e.g., 110-116 illustrated in FIG. 1), the Applicant submits that Safai's buttons 110-116 are not the same as the Applicant's recited buttons. Furthermore, the Applicant submits that Safai's buttons 110-116 do not perform substantially similar functions/operations as are recited in the pending claims. Cok cannot cure Safai in this regard because Cok does not disclose any structural features whatsoever, Cok being cited for the proposition of an example retouching method performed by a digital image editing software package (col. 1, lines 23-24) known as cloning or rubber stamping. Accordingly, it is submitted that claims 9 and 25 patentably define over Safai when taken alone or in combination with Cok.

In re Appln. of Sei-won Hong
Application No. 10/688, 517
Response to Final Office Action of November 14, 2007

The application is considered in good and proper form and the Applicant respectfully requests favorable reconsideration. If, in the opinion of the Examiner, a telephone conference would help resolve any issues that remain, the Examiner is invited to call the undersigned.

Respectfully submitted,

/brian c. rupp/

Brian C. Rupp, Reg. No. 35,665
David R. Morris, Reg. No. 53,348
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: May 12, 2008

CH02/ 22523096.1